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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,726	03/24/2004	Owen H. Decker	DPT.0002D1US	3691

7590 06/03/2005

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EXAMINER

WEDDINGTON, KEVIN E

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/807,726

Applicant(s)

DECKER ET AL.

Examiner

Kevin E. Weddington

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Claims 23-52 are presented for examination.

Applicants' preliminary amendment filed March 24, 2004 has been received and entered.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,093,407. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application teaches a method of preparing an anti-microbial powder coating composition comprising impact fusing one or more anti-microbial agents to particles of a resin-based powder; and the patented application teaches a further step incorporating into the method comprising treating the powder

coating particles by impacting them with particles containing an anti-microbial agent to adhere the anti-microbial agent to the coating powder particles. In the patented application's specification in column 3, lines 46-50 states "the particles of a solid anti-microbial agent may be bound with powder coating particles using impact fusion". Clearly, this statement states the impact fusion is optional, therefore, the impact fusion is capable of having its own invention as set forth in the present application.

Claim 23 is not allowed.

Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,432,416. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application teaches a method of preparing an anti-microbial powder coating composition comprising impact fusing one or more anti-microbial agents to particles of a resin-based powder; and the patented application teaches a further step incorporating into the method comprising treating the powder coating particles by impacting them with particles containing an anti-microbial agent to adhere the anti-microbial agent to the coating powder particles. In the patented application's specification in column 4, lines 1-6 states "the particles of a solid anti-microbial agent may be bound with powder coating particles using impact fusion". Clearly, this statement states

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the impact fusion is optional, therefore, the impact fusion is capable of having its own invention as set forth in the present application.

Claim 23 is not allowed.

Claims 23-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-22 and 53 of copending Application No. 10/185,545. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application 10/185,545 teaches an anti-microbial powder coating composition comprising one or more solid antimicrobial agents impact fused to particles of a resin-based powder (a product), and the present application teaches a method of preparing the instant anti-microbial powder coating composition comprising impact fusing one or more anti-microbial agent to particles of a resin-based powder of copending application 10/185,545 therein which makes the method claims of the present application an obvious variation of the copending claims since the method cannot work without the composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 23-30 are not allowed.

Claims 31-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of

U.S. Patent No. 6,093,407. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented application teaches an anti-microbial powder coating composition comprising an anti-microbial agent homogeneously dispersed within particles of a resin-based powder, and the present application teaches an anti-microbial powder coating composition comprising an anti-microbial silver zirconium phosphate that is homogeneously dispersed within particles of a resin-based powder. The patented application's instant composition encompasses the present application's composition since the broad anti-microbial agent encompasses the preferred anti-microbial agent, silver zirconium phosphate.

Claims 31-43 are not allowed.

Claims 31-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,432,416. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented application teaches an anti-microbial powder coating composition comprising one or more an anti-microbial metal or metal ion homogeneously dispersed within particles of a resin-based powder, and the present application teaches an anti-microbial powder coating composition comprising an anti-microbial silver zirconium phosphate (a metal ion) that is homogeneously dispersed within particles of a resin-based powder. The patented application's instant

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composition encompasses the present application's composition since the broad anti-microbial metal or metal ion encompasses the preferred anti-microbial metal or metal ion, silver zirconium phosphate.

Claims 31-37 are not allowed.

### ***Specification***

The use of the trademark FUNGITROL 11, PROPYL PARABENS, BUTYL PARABENS, AMERSTAT 300, NUOCIDE 960, NUOSEPT S, TROYSAN 174P, CANGUARD 409, IRGASAN DP 400, and AMICAL WP has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-52 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for solid antimicrobial agents,

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FUNGITROL 11, PROPYL PARABENS, BUTYL PARABENS, AMERSTAT 300, NUOCIDE 960, NUOSEPT S, TROYSAN 174P, CANGUARD 409, IRGASAN DP 400, and AMICAL WP; and antimicrobial metal or metal ion, silver, does not reasonably provide enablement for other antimicrobial agents or other antimicrobial metal or metal ions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

In this regard, the application disclosure and claims have been compared per factors indicated in the decision In re Wands, 8 USPQ2d 1400 (Fed. Cir., 1988) as to undue experimentation.

The factors include:

- 1) the quantity of experimentation necessary
- 2) the amount of direction or guidance provided
- 3) the presence or absence of working examples
- 4) the nature of the invention
- 5) the state of the art
- 6) the relative skill of those in the art
- 7) the predictability of the art and
- 8) the breadth of the claims



The instant specification fails to provide guidance that would allow the skilled artisan background sufficient to practice that instant invention without resorting to undue experimentation in view of further discussion below.

The nature of the invention, state of the prior art, relative skill of those in the art and the predictability of the art

The claimed invention relates to a method for preparing an anti-microbial powder coating composition comprising impact fusing one or more anti-microbial agents to particles of a resin-based powder; anti-microbial powder coating composition comprising an anti-microbial silver zirconium phosphate that is homogeneously dispersed within particles of a resin-based powder; and anti-microbial powder coating composition comprising one or more anti-microbial metals or metal ions homogeneously dispersed within particles of a resin-based powder.

The relative skill of those in the art is generally that of a Ph.D. or M.D.

The present invention is unpredictable unless experimentation is shown for the other antimicrobial agents and other antimicrobial metals or metal ions such as gold or zinc.

The breadth of the claims

The claims are very broad and inclusive to any antimicrobial agent; and all antimicrobial agents.

The amount of direction or guidance provided and the presence or absence of working examples

The working examples are limited to anti-microbial agents, FUNGITROL 11, PROPYL PARABENS, BUTYL PARABENS, AMERSTAT 300, NUOCIDE 960, NUOSEPT S, TROYSAN 174P, CANGUARD 409, IRGASAN DP 400, and AMICAL WP; and limited to anti-microbial metal or metal ion, silver.

The quantity of experimentation necessary

Applicants have failed to provide guidance as to show how the other antimicrobial agents or other antimicrobial metals or metal ions are effective in the coated powder composition. The level of experimentation needed to determine the other antimicrobial agents and other antimicrobial metals or metal ions is undue. Therefore, undue experimentation would be required to practice the invention as it is claimed in its current scope.

Claims 23-52 are not allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin E. Weddington whose telephone number is (571)272-0587. The examiner can normally be reached on 11:00 am-7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571)272-0951.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kevin E. Weddington  
Primary Examiner  
Art Unit 1614

K. Weddington  
June 1, 2005